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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/791,489 | 03/02/2004 | Yasuhiro Koyanagi | 170A 3545 | 1873 |

7590 12/08/2006

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| EXAMINER |
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RONESI, VICKEY M

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| ART UNIT | PAPER NUMBER |
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1714

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/791,489

Applicant(s)

KOYANAGI, YASUHIRO

Examiner

Vickey Ronesi

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, it is not made clear if the ratio of 1:4:1 includes the liquid from the emulsion of zirconium oxide or the emulsion of polyvinyl acetate. If so, then the amount of liquid (i.e., water, emulsifier, etc) is a critical parameter and the concentrations of zirconium oxide or polyvinyl acetate in their respective emulsions must be defined.

With respect to claim 1, the phrase “or a ratio approximating it” is indefinite because it is not made clear what the relative term “approximating” is intended to encompass. While the instant specification on page 4, lines 5-8 defines it as “the numerical values of the individual proportions of mixing ratio of the three ingredients are each allowed to increase or decrease within the limit of 20 percents,” it is not made clear if the 20 % refers to the numbers themselves such that the ratios include 0.8-1.2 : 3.2-4.8 : 0.8-1.2. Clarification is required.

With respect to claim 1, it is not made clear if the phrase following the term “ie” is a further embodiment of “three ingredients” or if it is an alternative embodiment.

With respect to claim 2, the terms “the agent” and “the fluorescent X-ray analysis” lack antecedent basis.

Art Unit: 1714

With respect to claim 2, the percentage amounts of elements are without basis, i.e., is it percent by weight or percent by mole or percent by volume?

With respect to claim 3, the term "said elements" lacks antecedent basis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quemin (US 2005/0129639).

Quemin discloses a makeup composition comprising 0.5-25 wt % pigment such as zirconium oxide (paragraphs 0108 and 0175); 0.5-40 wt % of an oil phase such as liquid paraffin (paragraphs 0090, 0100); and 0.01-5 wt % of a nonionic thickener such as a vinyl acetate copolymer (paragraph 0190 and 0201). These percentages provides for a ratio that overlaps with the presently claimed ratio of 1 : 4 : 1.

With respect to claims 1 and 2, while Quemin does not exemplify a composition comprising zirconium oxide, liquid paraffin, and vinyl acetate resin, this does not negate a finding of obviousness under 35 USC 103 since a preferred embodiment such as an example is not controlling. Rather, all disclosures "including unpreferred embodiments" must be considered. *In re Lamberti* 192 USPQ 278, 280 (CCPA 1976) citing *In re Mills* 176 USPQ 196 (CCPA 1972). Therefore, it would have been obvious to one of ordinary skill in the art to utilize

Art Unit: 1714

a composition comprising these ingredients given that Quemin teaches each one and thereby arrive at a composition which has the presently claimed X-ray analysis composition.

With respect to claim 3, these presently claimed elements are known impurities and as such are considered to be obviously present in the composition taught by Quemin, there being no showing or suggestion in the instant application that these elements contribute any advantage to the present invention. Rather, they are coincidentally present and cannot serve to patentably distinguish the instant claims from the prior art.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/791,489

Page 5

Art Unit: 1714

12/5/2006

Vickey Ronesi



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